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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,353	06/01/2001	Brian R. McCarthy	2991-US-B1	3630

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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08/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/872,353	Applicant(s) MCCARTHY ET AL.	
	Examiner ALICIA CHEVALIER	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/28/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 314-318,320-328,330,333-342,344-352,356-366,368-374,376,377,379-389,391-398,400,402-412 and 438.

Continuation of Disposition of Claims: Claims rejected are 314-318,320-328,330,333-342,344-352,356-366,368-374,376,377,379-389,391-398,400,402-412 and 438.

RESPONSE TO AMENDMENT

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 28, 2008 has been entered.
2. Claims 314-318, 320-328, 330, 333-342, 344-352, 356-366, 368-374, 376, 377, 379-389, 391-398, 400, 402-412 and 438 are pending in the application, claims 1-313, 319, 329, 331, 332, 343, 353, 355, 367, 375, 378, 390, 399, 401, 413-437 and 439-442 have been cancelled.
3. Amendments to the specification, filed on September 15, 2008, have been entered in the above identified application.
4. Amendments to the claims, filed on, September 15, 2008, February 12, 2009 and May 14, 2009, have been entered in the above-identified application.

Election/Restrictions

5. Applicant's election without traverse of Species I, the sheet of printable cards in the reply filed on February 12, 2009 is acknowledged. Applicant's election without traverse of Species A, the sheet without weakened fold line in the reply filed on May 14, 2009 is acknowledged.

The requirement is still deemed proper and is therefore made FINAL.

WITHDRAWN REJECTIONS

6. The objection to the specification, made of record in the office action mailed May 28, 2008, page 2, paragraph #9 has been withdrawn due to Applicant's amendment in the response filed September 15, 2008.

7. The 35 U.S.C. §112, first paragraph, rejection(s) of claims 331, 355, 378, 401 and 431, made of record in office action mailed November 1, 2007, page 3, paragraph #5 have been withdrawn due to Applicant's amendments in the response filed September 15, 2008.

REJECTIONS

8. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

9. Claims 314, 316-318, 320, 325, 330, 336-339, 341, 342, 344, 349, 354, 356, 361-366, 372, 376, 377, 379, 383, 385-389, 395, 400, 402, 406, 408-412 and 438 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip (U.S. Patent No. 5,462,488).

McKillip discloses a sheet of printable business cards, comprising: a cardstock sheet construction having a front side and a back side; a continuous liner sheet releasably secured with ultraremovable adhesive to and covering at least substantially all of the back side of the cardstock sheet construction; continuous through-cut lines through the cardstock sheet construction to the back side but not through-cut through the liner sheet; the through-cut lines defining at least in part perimeter edges of printable business cards and a matrix waste portion

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surrounding the printable business cards; portions of the back side of the cardstock sheet construction forming back side surfaces of the printable business cards; the printable business cards, the matrix waste portion, the liner sheet, the ultraremovable adhesive and the through-cut lines defining at least in substantial part a printable business card sheet construction; the printable business card sheet construction having dimensions such that the printable business card sheet construction can be sheet-fed through a printer or copier for a printing operation on the printable business cards to form printed business cards; areas of the liner sheet covering back sides of all of the through-cut lines, and being structurally capable of holding the printable business cards and the matrix waste portion together when the printable business card sheet construction is sheet-fed through the printer or copier for the printing operation; the ultraremovable adhesive allowing the printed business cards to be removed from the liner sheet and from the matrix waste portion and into individual printed business cards with the ultraremovable adhesive remaining on the liner sheet and not on back side surfaces of the printed business cards and thereby the back side surfaces being non-tacky and the exposed portion of the liner sheet being tacky; and the liner sheet being a solid continuous liner sheet (*figures 5 and 6 and col. 7, lines 16-30 and col. 2, lines 49-56*).

The preamble/limitation “business card” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that “business card” as the cut out portion or separable portion of the sheet construction (*specification page 1, lines 3-7 and page 3, line 25*

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through page 4, line 9). McKillip' labels are deemed to meet this limitation because McKillip' labels are also the cut out portion of the printable material.

It would be obvious to modify the laminate sheet construction of McKillip to be sized, constructed and capable of being sheet-fed through a printer or copier for a sheet-fed printing operation on the printable business cards, since one of ordinary skill in the art could have applied the known "improvement" technique, e.g. laser printer/sheet-fed printer, in the same way to the "base" device, e.g. dot-matrix/tractor feeding, and the results would have been predictable to one of ordinary skill in the art. *KSR, 82 USPQ2d at 1396*. Therefore, it would have been obvious to one of ordinary skill in the art to remove the perforated tractor feeding elements and have individual sheets of paper in order to utilize the new and better technology of laser printers, which are sheet fed. Each individual sheet has a solid continuous liner sheet.

The ultraremovable adhesive is deemed to be a suspension polymer ultraremovable adhesive with a primer coat between the ultraremovable adhesive and the liner sheet (*col. 7, lines 35-47*). The printable business card sheet construction is deemed not to have rupturable capsules. The liner sheet comprises base paper (*col. 5, lines 32-34*). The cardstock sheet construction comprises a top-coated cardstock sheet (*col. 9, lines 63-66*).

10. Claims 315, 321-324, 333-335, 340, 345-348, 357-359, 368-371, 380-382, 384, 391-394, 403-405 and 407 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip (U.S. Patent No. 5,462,488) in view of Popat et al. (U.S. Patent No. 5,407,718).

McKillip is relied upon as described above.

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McKillip fails to disclose that the printable business cards being arranged in a grid, the grid including a column of printable business cards, and adjacent ones of the printable business cards in the column directly abut one another and share a common edge or entire front faces of all of the printable business cards being free of any visible indicia.

Popat teaches label sheets used for printing with personal computers (*col. 1, lines 12-19*). The label sheets comprise a sheet construction that comprises a label layer, i.e. facestock sheet construction, and an adhesive layer, and backing layer (*col. 2, lines 64-68*), which acts as a release liner (*col. 3, lines 18-19*), i.e. carrier sheet.

Popat's label comprises facestock continuous through-cut lines (*die cut lines, col. 3, line 15*) that pass through the facestock sheet construction to the back side but not through-cut through the carrier sheet (*col. 3, lines 15-21*) and that the through-cut lines are deemed to define at least in part perimeter edges of printable business cards and a matrix waste portion around the printable business cards (*figure 1*). Areas of the carrier sheet are positioned over the back sides of all the through-cut lines and thereby the carrier sheet is constructed and adapted to hold the printable business cards and the matrix waste portion together during the printing operation (*figure 2 and col. 3, lines 15-21*). The carrier sheet and the through-cut lines are deemed to be constructed and adapted to allow the business cards to be removed and separated from the carrier sheet and from the matrix waste portion after the printing operation into individual printed business cards (*figure 1 and col. 3, lines 15-21*). The die cuts also help facilitate ease of feeding into complex printer paths, such as those found on laser printers (*col. 3, lines 1-4*).

McKillip and Popat are analogous because they are both discuss label sheets used for printing with personal computers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the die cut arrangement of the through-cut lines with the cuts only going through the facestock construction and not the carrier sheet of Popat as the die cuttings of McKillip in order to help facilitate ease of feeding into complex printer paths, such as those found on laser printers (*Popat col. 3, lines 1-4*). Furthermore, it would have been an obvious matter of design choice to change the configuration of the through-cut lines, since a modification would have involved a mere change in size of the label. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). Furthermore, it would have been to one of ordinary skill in the art at the time of the invention to have the entire front faces of all of the printable business cards being free of any visible indicia depending on what type of identification card the end user desires, e.g. a free form of their own design or a pre-filled one as a matter of aesthetic design choice. MPEP 2144.04 (I).

McKillip fails to disclose that the dry laminate sheet construction is 8.5 by 11 inches, 8.5 by 14 inches or has A4 width and length dimensions.

Popat discloses that the label sheet may be a standard 8.5 by 11 inch sheet or other dimensions such as sheets with smaller dimensions, legal size or various other sizes which allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (*col. 5, lines 1-11*).

Therefore, it would have been an obvious matter of design choice to change the size of sheet construction, since a modification would have involved a mere change in size. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV).

One of ordinary skill in the art would have been motivated to change the size of the sheet construction in order to allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (*Popat col. 5, lines 1-11*).

11. Claims 328 and 398 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip in view of Hollis et al. (U.S. Patent No. 5,622,758).

McKillip is relied upon as described above.

McKillip fails to disclose that the liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet or that the narrow exposed strip is approximately ½ inch wide.

Hollis discloses a label sheet comprising a backing sheet and one or more labels affixed to the backing with adhesive (*col. 5, line 62 through col. 6, line 20*). The backing sheet has a leading edge and a trailing edge that extends out to form a narrow exposed strip extending the entire width of the liner sheet (*col. 5, line 67 through col. 6, line 1 and figures 3 and 4*). The label sheet is easily loaded into machinery (*col. 4, lines 49-51*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have McKillip's liner sheet end edge extends out to form a narrow exposed strip extending the entire width of the liner sheet as taught by Hollis in order to make the sheet material easy to load into machinery.

The exact size of the narrow exposed strip of the liner sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as size of the narrow exposed

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strip, through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

12. Claims 326, 327, 350, 351, 373, 374, 396 and 397 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

McKillip is relied upon as described above.

McKillip fails to disclose that an edge of the sheet is thinner than a body of the sheet or that the sheet is calendared.

Examiner's comment: The limitation "the printable business card sheet is calendared" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendared end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the printable business card sheet is calendared," since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (*col. 6, lines 9-16*). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (*col. 1, lines 38-51*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet of McKillip as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing. One of ordinary skill in the art

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would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at col. 1, lines 38-51. It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

ANSWERS TO APPLICANT'S ARGUMENTS

13. Applicant's arguments in the response filed September 15, 2008 regarding the claim 413 of record have been considered but are moot since claim 413 has been cancelled.

14. Applicant's arguments in the response filed September 15, 2008 regarding the claims 363 and 387 of record have been carefully considered but are deemed unpersuasive.

Applicant argues that independent claim 363 includes "a primer coat between the ultraremovable adhesive and the liner sheet" and independent claim 387 includes that the liner sheet is "a primer-coated liner sheet," which is not taught by McKillip. Rather McKillip discloses that the adhesive is applied directly to the upper surface 37 of the "liner sheet."

McKillip discloses that the ultraremovable adhesive (*ref. # 28, figure 6*) has an adhesive deadner, e.g. primer coat, applied on the bottom surface next to the liner sheet (*col. 4, lines 9-21*). Furthermore, the adhesive with primer coat is coated on liner sheet (*ref. #22, figure 6*) (*col. 8, lines 22-31*). Therefore, since the adhesive deadner is on the bottom surface of adhesive and the adhesive is coated on the liner sheet, McKillip discloses "a primer coat between the ultraremovable adhesive and the liner sheet" and "a primer-coated liner sheet."

15. Applicant's arguments in the response filed September 15, 2008 regarding the claim 314 of record have been carefully considered but are deemed unpersuasive.

Applicant argues that McKillip does not disclose that “the ultraremovable adhesive providing only partial contact with the cardstock sheet construction and the partial contact prevent the ultraremovable adhesive from becoming permanent over time.”

As pointed out above, McKillip discloses that the ultraremovable adhesive (*ref. # 28, figure 6*) has an adhesive deadner, e.g. primer coat, applied on the bottom surface next to the liner sheet (*col. 4, lines 9-21*). Furthermore, the limitation “the ultraremovable adhesive providing only partial contact with the cardstock sheet construction and the partial contact prevent the ultraremovable adhesive from becoming permanent over time” is a functional limitation and is deemed to be a latent property of the prior art since the prior art is substantially identical in composition and/or structure, e.g. an adhesive deadner/primer coat between the adhesive and liner. MPEP 2145 (II).

16. Applicant’s arguments in the response filed September 15, 2008 regarding the claims 314 and 339 of record have been carefully considered but are deemed unpersuasive.

Applicant’s arguments regarding claim 314 have already been addressed above.

Applicant argues that McKillip does not disclose a “suspension-polymer ultraremovable adhesive.” Applicant has not specifically pointed out how the adhesive of McKillip differs from that claimed in claim 339.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/
Primary Examiner, Art Unit 1794
8/4/2009